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PIO SB.21 (08-00)

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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	08 926,592	
	Filing Date	September 9, 1997	
	First Named Inventor	Shunpei YAMAZAKI	
	Group Art Unit	2813	
	Examiner Name	M. Whipple	
Total Number of Pages in This Submission		Attorney Docket Number	740756-001717

ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Response to Election of Species <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits declarations <input checked="" type="checkbox"/> Extension of Time Request (4 month) <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts-Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Jeffrey L. Costellia Nixon Peabody LLP 8180 Greensboro Drive Suite 800 McLean, VA 22012
Signature	
Date	April 13, 2001

CERTIFICATE OF MAILING

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Pamela L. Patrick

**FEE TRANSMITTAL
FOR FY 2001**

Patent fees are subject to annual revision

**Complete if Known**

Application Number	08 926,592
Filing Date	September 9, 1997
First Named Inventor	Shunpei YAMAZAKI
Examiner Name	M. Whipple
Group Art Unit	2813
Attorney Docket No	740756-1717

TOTAL AMOUNT OF PAYMENT**METHOD OF PAYMENT**

1. ☐ The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit Account Number: 19-2380

Deposit Account Name: Nixon Peabody LLP

- ☒ Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17

- ☐ Applicant claims small entity status See 37 CFR 1.27

2. ☐ **Payment Enclosed:**

☐ Check ☐ Credit Card ☐ Money Order ☐ Other

FEE CALCULATION**1. BASIC FILING FEE**

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
101	710	201	355	Utility filing fee	
106	320	206	160	Design filing fee	
107	490	207	245	Plant filing fee	
108	710	208	355	Reissue filing fee	
114	150	214	75	Provisional filing fee	

SUBTOTAL (1) (\$)**2. EXTRA CLAIM FEES**

Total Claims	Extra Claims	Fee from below	Fee Paid
20**	X		
Independent Claims	3**	X	
Multiple Dependent			

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
103	18	203	9	Claims in excess of 20	
102	80	202	40	Independent claims in excess of 3	
104	270	204	135	Multiple dependent claim, if not paid	
109	80	209	40	** Reissue independent claims over original patent	
110	18	210	9	** Reissue claims in excess of 20 and	

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English transaction	
147	2,520	147	2,520	For filing a request for ex parte reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	390	216	195	Extension for reply within second month	
117	890	217	445	Extension for reply within third month	
118	1,390	218	695	Extension for reply within fourth month	1,390
128	1,890	228	945	Extension for reply within fifth month	
119	310	219	155	Notice of Appeal	
120	310	220	155	Filing a brief in support of an appeal	
121	270	221	135	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,240	241	620	Petition to revive - unintentional	
142	1,240	242	620	Utility issue fee (or reissue)	
143	440	243	220	Design issue fee	
144	600	244	300	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Petitions related to provisional applications	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	710	246	355	Filing a submission after final rejection (37 CFR 1.129(a))	
149	710	249	355	For each additional invention to be examined (37 CFR 1.129(b))	
179	710	249	355	Request for Continued Examination (RCE)	
160	700	160	350	For each additional submission of a design application	
Other fee (specify):					

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* Reduced by \$11,390.00

SUBMITTED BY

Jeffrey E. Costellina

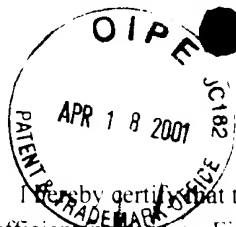
Signature

Filing Date: 08/13/2001

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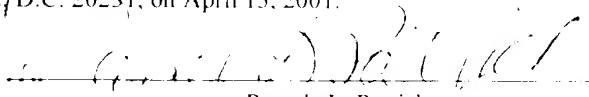
Date: April 13, 2001

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Pamela L. Patrick

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
Shunpei YAMAZAKI)	
Serial No. 08/926,592)	Art Unit: 2813
Filed: September 9, 1997)	Examiner: M. Whipple
For: LAYER MEMBER FORMING)	
METHOD)	Date: April 13, 2001

RESPONSE TO ELECTION OF SPECIES

Honorable Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

In response to the request for election of species in the Office Action of November 15, 200, Applicant hereby elects with traverse species IV (claim 26).

The Office Action provides that claim 13 is generic to Species I, II, III and VI. Applicant contends that claim 13 is generic to species IV since claim 13 recites the vapor deposit of two layers wherein the material of the two layers is not specified.

Applicant also contends that the instant election of species is improper since it is brought after two actions on the merits. Although M.P.E.P. 811 provides that an election requirement can be made any time prior to a final rejection, the Examiner is instructed to make such a requirement as early as possible, in the first action if possible, otherwise, as soon as the need for a proper requirement arises. Further, the Examiner is instructed to consider whether there will be a serious burden if restriction is not required when made

Applicant is also submitting an amendment to the pending claims and the amendment adds new claims. Moreover, this amendment was filed in response to the first action on the merits.

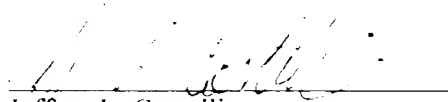
not the second. Further, although the amendments to the claims were broadening in nature, they did not result in a fundamental change from the invention originally claimed. As a result, the designation of 10 different species at this stage in the prosecution is highly burdensome to Applicant since time and investment have already been made by Applicant in this case on two different occasions to obtain allowance of the pending claims.

This type of species election is also inconsistent with standard claiming practice wherein an application may contain a number of claims of varying scope that may be patentably distinct from one another, but also properly considered in the same application. Just because many of the claims falling within the designated species are independent claims does not give rise to a proper species election requirement. Otherwise, the same reasoning would have to be applied to ever increasingly narrow dependent claims included in the same application, since dependent claims are treated as stand alone claims for examination and infringement purposes. If the species election of the instant Office Action were proper, applications could basically only include two claims, namely, one generic claim and one more specific claim. This is particularly true with respect to the dependent claims grouped separately by the Examiner in this case as separate species.

It should be noted that these arguments do not assert and should not be construed to assert that the embodiments provided in each of the designated species are not patentably distinct from one another.

Filed Concurrently herewith is a Request for a Four Month Extension of Time which extends the shortened statutory period of response to April 15, 2001. Accordingly, applicant respectfully submits that this response is being timely filed.

Respectfully submitted,



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